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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,563	03/09/2001	Raimond Lasar	01LASR01PN	7303

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LAWRENCE ROBERT BRANDT
P.O. BOX 1937
SAXONVILLE, MA 01701

EXAMINER

MELWANI, DINESH

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 06/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,563

Applicant(s)

LASAR, RAIMOND

Examiner

Dinesh N Melwani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/09/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Germany on 03/09/200 and 12/11/2000. It is noted, however, that applicant has not filed a certified copy of the German applications as required by 35 U.S.C. 119(b).

Acknowledgement is made of the applicant's submission of:

Preliminary Amendment A on 08/31/01

The aforementioned item has been noted and officially inserted into the application.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the primary attachment of the decorative section having internal threading, the primary attachment of the head section including a threaded pin, and the primary attachment of the head section including a fork-shaped attachment must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claim 25, the applicant has not disclosed or has not shown in the accompanying drawings the primary attachment of the decorative section having internal threading or the primary attachment of head section including a threaded pin. In regards to claim 26, the applicant has not disclosed the primary attachment of the head section having a fork-shaped attachment.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant discloses the body piercing section having a secondary and a primary end, wherein said ends include external threading. Furthermore, the applicant has also disclosed the primary attachment of the fastening section having external threading. It has been determined that the claimed invention will not be able to function, in that with both the body piercing section and the fastening section having external threading, a detachable mating engagement can not be achieved. For the purpose of examination and as shown in the

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drawings, the threading of the fastening section has been treated as being of the internal kind.

See claim 16, line 9 and claim 17, line 5.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "preferably" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 19 and 20 recites the broad recitation less than 180 degrees, and the claim also recites more preferably between 90 and 180 degrees which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

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person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson (U.S. Patent No. 4,781,036) in view of Hoffman et al. (U.S. Patent No. 2,316,225). Erickson discloses a body decoration system substantially as claimed, wherein said system comprises a body piercing section (10) having a primary end, a secondary end, and a diameter (see Figure 1), a fastening section (14) having a diameter greater than that of the piercing section and a primary attachment being detachably related in mating engagement with the primary end of the body piercing section. Erickson does not include a head section having a secondary attachment and a primary attachment for engagement with the body piercing section and a decorative section, respectively. Hoffman discloses a body decoration system that teaches the use of a head section (4), wherein said section includes a secondary attachment (A), and a primary attachment for receiving threaded pin (B), providing a detachable mating engagement with a decorative section (6). Hoffman's decorative section includes a primary attachment (B) being detachably related in mating engagement to the head section. Hoffman further includes a decorative element being affixed to the primary attachment, wherein said decorative section may be removed and replaced with a different decorative section without removing the head section or said fastening section. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to utilize the teachings of Hoffman, in regards to a detachable decorative section, on Erickson's device to facilitate the interchanging of decorative elements on body jewelry, thereby giving the wearer numerous options.

9. Claims 2-7, 9, 10, 12, 13, 15-17, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson (U.S. Patent No. 4,781,036) in view of Hoffman et al. (U.S. Patent

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No. 2,316,225), in further view of Beard (U.S. Patent No. 5,992,177). Erickson discloses a body decoration system substantially as claimed, wherein said system included an axis of rotational symmetry lying on a central axis of rotational symmetry and the primary attachment of the decorative section being disposed along said axis of said decorative section. The head section also having an axis of rotational symmetry lying on a central axis of rotational symmetry and the primary attachment of said head section being disposed along the axis of said head section. Furthermore, Erickson's invention discloses the head section having a flattened area being defined by a plane which is normal to said central axis of rotational symmetry. Erickson's flattened area has an external diameter but does not include a decorative section having a ring-shaped fastening section nor a portion forming a central hollow area in the head section. Beard discloses a gem mount and teaches the use of a head section (10) having a flattened area (C), wherein said area has an external diameter and a portion forming a central hollow area (see Figure 1). Beard's hollow portion includes an internal diameter, smaller than the external diameter, and a base point disposed along a central rotational axis of the head section. Beard also discloses the use of a substantially circular shaped stop area being created between the internal and external diameters (see Figure 1). Additionally, Beard's head section includes a primary attachment (11) being positioned at the base point of the hollow portion (see Figure 1). Hoffman discloses a body decoration system, wherein said system includes a decoration system having a ring-shaped fastening section (4). The ring shaped fastening section being substantially centered about the central rotational axis of rotational symmetry, and said ring shaped fastening section being in contact with a circular shaped stop area when the primary

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attachment of said decorative section is engaged with the primary attachment of the head section, whereby said decorative section is strengthened and supported by the head section.

10. In regards to claim 3, Erickson discloses a body decoration system substantially as claimed, wherein said system includes a head section having a primary attachment, whereby said attachment includes a friction element. Erickson does not include said element being frictionally related in mating engagement with a primary attachment of a decorative section. Hoffman teaches the use of a friction element (B) on said decorative section, wherein said element is frictionally related in mating engagement with head section (3).

11. Regarding claim 4, Erickson discloses a body decoration system substantially as claimed, but does not include a decorative section having a primary attachment including a pin, and the friction element of the head section comprising a material selected from the group consisting of rubber and foam rubber. Hoffman discloses a body decoration system that teaches the use of a decoration section having a pin (55), whereby said pin is inserted and held by the friction element of the head section. Hoffman's pin is fabricated from a resilient material, wherein when said material is squeezed it exerts a force creating a frictional bond with its surroundings.

12. Regarding claim 5, Erickson discloses a body decoration system substantially as claimed, but does not disclose a decorative section having a threaded pin, whereby said pin is threadedly related in detachable mating engagement to the internal threading of the head section's primary attachment. Hoffman discloses a body decoration system that teaches the use of a threaded pin (B) on a decorative section to detachably engage the internal threading of a head section (3) n Figure 1.

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13. In regards to claim 6, Erickson discloses a body decoration system substantially as claimed, but does not disclose the use of a spring element in the mating engagement of the decorative section and head section. Hoffman discloses a body decoration system that teaches the use of a detachable mating engagement, wherein said engagement is achieved with the decorative section having a section with gradually increasing diameter (40) and the head section including spring elements (49). See Figure 4, and column 2, lines 40-55.

14. Regarding claim 7, Erickson discloses a body decoration system substantially as claimed, but does not comprise a decorative section including a primary attachment having a first diameter and a decorative element having a second diameter, wherein the ratio of said diameter is a ratio selected from the group consisting of 1, 1:2, 1:3, 1:5, and 1:7. Hoffman discloses a body decoration system that teaches the use of a primary attachment (D in Figure 8) having a diameter in a 1:1 ratio with decorative element (88).

15. In regards to claim 9, Erickson discloses a body decoration system substantially as claimed, but does not include a decorative section having a decorative element and being attached to a head section. Hoffman teaches the use of a decorative section including a mounting (E) having an attachment point, wherein a decorative element (6) is permanently attached to said point. Additionally, the primary attachment of the head section (B) being attached at said point of said mounting. See Figure 1.

16. Regarding claims 10 and 12, Erickson discloses a body decoration system substantially as claimed, wherein said system comprises a straight rod having a circular cross section.

17. Regarding claims 13 and 15, Erickson discloses a body decoration system comprising a piercing section, comprising a piercing pin, and a fastening section, wherein the primary end of

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the primary section includes external threading and the primary attachment of the fastening section includes internal threading. The body piercing section being removably threadedly related in mating engagement with the primary attachment of the fastening device (see Figure 1).

18. In regards to claims 16 and 17, Erickson discloses a body decoration system substantially as claimed, wherein said system comprises a body piercing section having including primary and secondary ends having external threading, a head section including a secondary attachment having internal threading and a fastening section including a primary attachment having internal threading, wherein said threading is the same throughout the system.

19. Regarding claim 25, Erickson, Hoffman, and Beard disclose a body decorating system substantially as claimed, but do not show the primary attachment of the decorative section having internal threads and the primary attachment on the head section including a pin having external threads. It is however deemed obvious to provide Erickson's system as modified by Hoffman and Beard with a decorative section having internal threads and a threaded pin with external threads since this is a mere reversal of the parts shown in Figure 1 of Hoffman.

20. In regards to claim 26, Erickson discloses a body decorating system substantially as claimed, but does not disclose the primary attachment of the decorative section including a protuberance, and the primary attachment of the head section including a fork-shaped attachment. Hoffman discloses a body decorating system that teaches the use of a protuberance (55) and fork-shaped receiving area (surrounding 52) to serves as primary attachment between a decorative section and a head section. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to utilize the teachings of Hoffman and Beard,

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in regard to a detachable decorative section having various engagement means and a hollow portion in the head section, respectively, on Erickson's device to facilitate the interchanging of decorative elements on body jewelry, thereby giving the wearer numerous options.

Additionally, providing the manufacturer with options regarding the best attachment means as no single means is best for all parts of the body. Furthermore, Beards teaching of a hollow area, wherein a decorative element is placed also allows for a flush mounting in areas where projections may be irritating to the wearer, such as the mouth.

21. Claims 11, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson (U.S. Patent No. 4,781,036), Hoffman et al. (U.S. Patent No. 2,316,225), and Beard (U.S. Patent No. 5,992,177) in view of Kaping Jr. (U.S. Patent No. 6,026,659). Erickson, Hoffman, and Beard disclose a body decoration system substantially as claimed, but do not disclose a body piercing section having a curved rod. Kaping discloses a body jewelry device teaching the use of a body piercing section having a curved rod (see Figure 6). Kaping's rod includes a primary end having a first axis and a secondary end having a second axis, wherein the angle between said axes varies between 0° and 180°.

22. In regards to claim 14, Erickson, Hoffman, and Beard disclose a body decoration system substantially as claimed and disclose the use of a fastening section but do not disclose said section being spherical in shape. Kaping discloses a body jewelry device teaching the use of a spherical fastening section. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaches of Kaping, in regards to a curved rod and a spherical fastening section, on Erickson's system as modified by Hoffman and Beard to allow for Erickson's system to be adaptable for use in various body parts as well as to

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ensure smooth contact between said fastening section and adjacent body flesh, thereby reducing irritation suffered by the wearer.

23. Claims 8 and 24 are rejected is under 35 U.S.C. 103(a) as being unpatentable over Erickson (U.S. Patent No. 4,781,036), Hoffman et al. (U.S. Patent No. 2,316,225), and Beard (U.S. Patent No. 5,992,177) in view of Hollingworth (6,138,333). Erickson, Hoffman, and Beard disclose a body decoration system substantially as claimed, but do not include a head section having a central hollow section, wherein said section is essentially of a conical-joint shape nor a decorative section having the same shape. Hollingworth discloses a body decoration system that teaches the use of a decorative section (generally 12) having an essentially conical-joint shape and a hollow section (23) having a similar shape.

Hollingworth's conically-joint-shaped decorative section includes a tip, wherein the primary attachment of said decorative section is attached at said tip, and furthermore, said tip being detachably related in mating engagement with the primary attachment of section (19).

24. In regards to claim 24, Erickson discloses a body piercing section comprising a primary end having external threading and a primary attachment of a fastening section having internal threading, wherein said sections are removably threadedly related in mating engagement. It would have been obvious to one having ordinary skill in the art at the time of invention to utilize the teachings of Hollingworth, in regards to a conically shaped engagement method, on Erickson's system as modified by Hoffman and Beard to facilitate and snug and secure fit between said detachable decorative section and the head section.

25. Claims 20, 21, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson (U.S. Patent No. 4,781,036), Hoffman et al. (U.S. Patent No. 2,316,225), and

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Hollingworth (U.S. Patent No. 6,138,333), in view of Kaping Jr. (U.S. Patent No. 6,026, 659). Erickson discloses a body decoration system as claimed, wherein said system comprises a body piercing section including primary and secondary ends having external threads and said section having a diameter and circular cross section. However, Erickson does not disclose said body piercing section comprising a curved rod. Erickson also includes a fastening section (14) having a diameter, said diameter being greater than the diameter of said body piercing section, and providing a primary threaded attachment to the primary attachment of the body piercing section. Furthermore, Erickson also discloses a head section, but does not include said head section having primary and secondary attachments and a hollow area. Kaping discloses a body jewelry device that teaches the use of a curved body piercing section, see Figure 6. Kaping's rod includes a primary end having a first axis and a secondary end having a second axis, wherein the angle between said axes varies between 0° and 180°. Hollingworth disclose a body decorating system that teaches the use of a head section (19) having an outside diameter, a portion forming a hollow area having an inside diameter and internal threads. The internal threading of said hollow area providing a primary attachment allowing for detachable mating engagement. Hoffman discloses a body decorating system that teaches the use a head section having a primary as well as a secondary attachment, wherein said secondary attachment is designed to be engaged with the section actively retaining said decorating system to the body. Hollingworth also teaches the use of a decorative section comprising a decorative element, an essentially cylindrical mounting for said element, wherein said mounting includes an outside diameter, a top, a bottom, and an outside surface. Hollingworth's system also includes a decorative element (12) being permanent attached to a decorative element attachment at the top

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of said mounting. Additionally, Hollingworth's mounting includes external threading attached to the outside surface, providing primary mating engagement between said decorative section and said head section. Furthermore, the diameter of said hollow area in said head section is essential 20% less than the diameter of the decorative element section.

26. In regards to claim 21, the method of creation a body decoration system comprising the steps outlined by the applicant is deemed inherent over the prior art of record because the teachings of the references taken as a whole necessitate providing of recited elements as well respective engagements between said elements.

27. Regarding claim 22, the method of attaching and replacing the body decoration system comprising the steps outlined by the applicant is deemed inherent over the prior art of record because the teachings of the references taken as a whole necessitate providing of recited elements as well respective engagements between said elements. It would have been obvious to one having ordinary skill in the art at the time of invention to utilize the teachings of Hoffman, Hollingworth, and Kaping on Erickson's system to facilitate the changing of a decorative element on a body decorating device designed to be adorned on various parts of the body. Furthermore, it would have been obvious to provide the necessary components as well as carry out the necessary steps inherent of the structure as shown in Erickson, Hoffman, Hollingworth, and Kaping.

Allowable Subject Matter

28. Claim 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations

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of the base claim and any intervening claims. The following is an examiner's statement of reasons for allowance: Claim 18 would be allowable over the prior art of record because the teachings of the references taken as a whole do not show or render obvious the combination set forth, including an angle of 90°-135° between a primary attachment axis and a secondary attachment axis of the body piercing section.

29. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kaping Jr. (U.S. Patent No. 6,244,073) and Siekierski (U.S. Patent No. 6,167,725) disclose body-decorating systems similar to that recited by the applicant.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinesh N Melwani whose telephone number is 703-305-4546. The examiner can normally be reached on M-F, 8:30-6 except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4115.

DNM

June 6, 2002



**ROBERT J. SANDY
PRIMARY EXAMINER**